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EXAMINER

PASS, NATALIE

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3626

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/589,647
Filing Date: June 07, 2000
Appellant(s): MCCOLLUM ET AL.

MAILED

NOV 30 2004

GROUP 3600

Matthew B. Lowrie (et al.)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 13 September 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

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(7) *Grouping of Claims*

The rejection of claims 1-26 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

1. 5, 659, 741 A	Eberhardt	08-1997
2. 5, 737, 539 A	Edelson et al	04-1998
3. 6, 018, 713 A	Coli et al	01-2000

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-26 are rejected under 35 U.S.C. § 103(a).

These rejections are set forth in prior Office Action, Paper No. 9 and reproduced hereinbelow. The rejections that appear below substantially repeat the rejections made in the previous Office Action (Paper No.9). The text of those sections of Title 35 U.S. Code relied upon in the Examiner's Answer is set forth in the previous Office action, Paper No. 9.

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1. Claims 1-2, 4-10, 12-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eberhardt, U.S. Patent Number 5, 659, 741 in view of Edelson et al, U.S. Patent Number 5, 737, 539.

(A) As per claim 1, Eberhardt teaches a method of obtaining a patient record or document using an online location on an electronic medium (Eberhardt; Figure 1), comprising:

requesting an order, by a requestor, for the patient record or document from the online location (Eberhardt; Figure 1, column 8, lines 31-34, column 9, lines 44-48).

Eberhardt fails to explicitly disclose:

providing to the requestor a cover letter or authorization having an identifier, the identifier having order information;

sending, by the requestor, the cover letter along with a patient authorization letter to a processing center, for completing the order;

requesting, by the processing center, to a shipping location to ship the patient record or document to a destination location; and

obtaining, by the requestor, the patient record or document from the destination location.

Edelson teaches:

providing to the requestor a cover letter or authorization having an identifier, the identifier having order information (Edelson; column 16, lines 10-24, column 17, lines 5-62);

sending, by the requestor, the cover letter along with a patient authorization letter or electronic release to a processing center, for completing the order (Edelson; column 9, lines 23-28, column 9, line 66 to column 10, line 14, column 15, lines 25-27, column 16, lines 10-24, column 17, lines 5-62, column 31, lines 55-63);

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requesting, by the processing center, to a shipping location to ship the patient record or document to a destination location (Edelson; Figure 3, Item 80, column 26, line 56 to column 27, line 5, column 31, lines 48-63, column 45, lines 55-64); and

obtaining, by the requestor, the patient record or document from the destination location (Edelson; column 10, lines 55-66, column 14, lines 19-24, 53-60, column 48, lines 10-20, column 50, lines 54-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of obtaining a patient record or document using an online location on an electronic medium of Eberhardt, to include providing to the requestor a cover letter or authorization having an identifier, the identifier having order information; sending, by the requestor, the cover letter along with a patient authorization letter to a processing center, for completing the order; requesting, by the processing center, to a shipping location to ship the patient record or document to a destination location; and obtaining, by the requestor, the patient record or document from the destination location, as taught by Edelson, with the motivation of making integrated patient-specific information readily available to medical prescribing professionals, to utilize medical information which is widely distributed geographically, and to enable such access in the light of proprietary, liability and patient confidentiality concerns (Edelson; column 2, lines 8-15).

(B) Claim 2 differs from claim 1 in that it is a system for obtaining a patient record or document using an online location on an electronic medium rather than a method of obtaining a patient record or document using an online location on an electronic medium.

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As per claim 2, Eberhardt and Edelson teach a system for obtaining a patient record or document using an online location on an electronic medium (Eberhardt; Figure 1), comprising:

means for requesting, by a requestor, an order for the patient record or document from the online location (Eberhardt; Figure 1, column 8, lines 31-34, column 9, lines 44-48);

means for providing the requestor a cover letter having an identifier for identifying the order (Edelson; column 16, lines 10-24, column 17, lines 5-62);

means for sending, by the requestor, the cover letter along with a patient authorization letter to a processing center (Edelson; column 9, lines 23-28, column 9, line 66 to column 10, line 14, column 15, lines 25-27, column 16, lines 10-24, column 17, lines 5-62, column 31, lines 55-63);

means for requesting the patient record or document from a shipping location (Edelson; Figure 3, Item 80, column 26, line 56 to column 27, line 5, column 31, lines 48-63, column 45, lines 55-64);

means for receiving, by a destination location, the patient record or document from the shipping location (Edelson; column 17, lines 37-39, column 34, lines 17-20, column 48, lines 14-20); and

means for obtaining the patient record or document from the destination location (Edelson; column 10, lines 55-66, column 14, lines 19-24, 53-60, column 48, lines 10-20, column 50, lines 54-60).

The motivations for combining the respective teachings of Eberhardt and Edelson are as given in the rejection of claim 1 above, and incorporated herein.

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(C) As per claims 4-6, Eberhardt and Edelson teach a method described in claim 1 above,

wherein the requestor comprises an insurance company (Eberhardt; column 8, lines 49-52);

further comprising inputting patient information in a graphical user interface window before requesting the order (Eberhardt; column 6, lines 12-21, column 8, line 62 to column 9, line 8); and

wherein the patient information includes at least one of a claim number, first name, last name, social security number, and date of birth (Eberhardt; column 3, lines 55-68).

(D) As per claims 7-9, Eberhardt and Edelson teach a method described in claim 1 above

wherein the identifier comprises a bar code (Edelson; column 51, lines 23-28);

wherein sending the cover letter comprises faxing the cover letter to the processing center (Edelson; column 17, lines 52-55); and

further comprising automatically reading and identifying, by the processing center, the identifier on the cover letter (Edelson; column 8, lines 39-44, column 51, lines 23-28).

(E) As per claims 10, 12-13, Eberhardt and Edelson teach a system described in claim 2 above,

wherein the requestor comprises an insurance company (Eberhardt; column 8, lines 49-52);

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wherein the means for requesting the order comprises inputting patient information in a graphical user interface window (Eberhardt; column 6, lines 12-21, column 8, line 62 to column 9, line 8); and

wherein the identifier comprises a bar code (Edelson; column 51, lines 23-28).

(F) As per claims 14-15, Eberhardt and Edelson teach a system described in claim 2 above, wherein sending the cover letter comprises faxing the cover letter to the processing center (Edelson; column 17, lines 52-55) and wherein sending the cover letter comprises mailing the cover letter to the processing center (Edelson; Figure 1, Item 16, column 12, lines 5-13).

(G) Claim 16 differs from claims 1 and 2 in that it is a method of ordering, by a requestor, a patient record or document using an online location rather than a method of obtaining a patient record or document from an online location or a system for obtaining a patient record or document using an online location.

As per claim 16, Eberhardt and Edelson teach a method of ordering, by a requestor, a patient record or document using an online location, comprising:

requesting an order for the patient record or document from the online location (Eberhardt; Figure 1, column 8, lines 31-34, column 9, lines 44-48);

providing to the requestor a cover letter having an identifier, the identifier having order information (Edelson; column 16, lines 10-24, column 17, lines 5-62); and sending the cover letter along with a patient authorization letter to a processing center associated with the online location for completing the order (Edelson; column 9, lines 23-28, column 9,

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line 66 to column 10, line 14, column 15, lines 25-27, column 16, lines 10-24, column 17, lines 5-62, column 31, lines 55-63).

The motivations for combining the respective teachings of Eberhardt and Edelson are as given in the rejection of claim 1 above, and incorporated herein.

(H) As per claims 17-20, Eberhardt and Edelson teach a method described in claim 16 above

wherein the requestor comprises an insurance company (Eberhardt; column 8, lines 49-52);

further comprising inputting patient information in a graphical user interface window before requesting the order (Eberhardt; column 6, lines 12-21, column 8, line 62 to column 9, line 8);

wherein the identifier comprises a bar code (Edelson; column 51, lines 23-28); and

wherein sending the cover letter comprises faxing the cover letter to the processing center (Edelson; column 17, lines 52-55).

(I) As per claims 21-26, Eberhardt and Edelson disclose a method and system as analyzed and disclosed in the rejections of claims 1, 2, and 16 above

wherein said cover letter is a paper letter or hard copy or a printout (Edelson; column 9, lines 29-35, column 15, lines 25-27, column 17, lines 42-55); and

wherein said patient authorization letter is a paper letter or hard copy or a printout (Edelson; column 9, lines 29-35, column 15, lines 25-27, column 17, lines 42-55).

2. Claims 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eberhardt, U.S. Patent Number 5, 659, 741 and Edelson et al, U.S. Patent Number 5, 737, 539, as applied to claims 1 and 2 above, and further in view of Coli et al, U.S. Patent Number 6, 018, 713.

(A) As per claims 3 and 11, Eberhardt and Edelson teach a system and method discussed above, in claims 1 and 2.

Eberhardt and Edelson teach the online location comprising the Internet (Eberhardt; column 7, lines 21-24) (Edelson; column 47, lines 1-7), but fail to explicitly disclose a method wherein the online location comprises a web site.

Coli teaches a system and method wherein the online location comprises a web site (Coli; see at least column 8, lines 56-60, column 10, lines 15-18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of obtaining a patient record or document using an online location on an electronic medium of Eberhardt and Edelson to include wherein the online location comprises a web site, as taught by Coli, with the motivation of providing integrated results reporting in a consistent and easy-to-understand manner within a system that provides effective communication of test orders, medical records and results between a physician's office and a remote user, allowing appropriate transmission of test orders and medical records, preferably over the Internet (Coli; column 2, lines 52-63).

(11) Response to Argument

In the Appeal Brief filed 13 September 2004, Appellant makes the following arguments:

The Rejections of Claims 1-26 Should Be Reversed.

1. Claims 1-26 are Not Obvious Over Eberhardt in view of Edelson.

Examiner will address Appellant's arguments in sequence as they appear in the brief.

1. Claims 1-26 are Not Obvious Over Eberhardt in view of Edelson.

With respect to Appellant's argument in paragraph 2 of page 7 of the Appellant's Brief that a *prima facie* case of obviousness has not been established and that "the reference(s) must teach or suggest all of the claimed features," the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence has been presented of corresponding claim elements in the prior art and the combinations and the motivations for combinations that fairly suggest Appellant's claimed invention (see paper number 9 and present Office Action) have been expressly articulated.

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In response to Appellant's assertion starting in paragraph 4 on page 7 and continuing to the bottom of page 8 of the Appellant's Brief that "Eberhardt and Edelson fail to disclose or suggest two features of claim 1, specifically 'providing to the requestor a cover letter having an identifier, the identifier having order information' and 'sending, by the requestor, the cover letter along with a patient authorization letter to a processing center, for completing the order,'" Examiner respectfully disagrees. Examiner notes that on page 11 of Appellant's specification in paragraph 2 Appellant defines "cover letter" to be as follows:

"After making all the necessary selections, the insurance company is provided with 'an authorization for release of records and documents' cover letter ("cover letter" hereinafter) in step 414. The cover letter can be downloaded ...[...]...in PDF format or any other format...[...]...establishes a unique identifier for each order."

Thus, when given its broadest reasonable interpretation, a "cover letter" is nothing more than an authorization provided for completing an order or for releasing information. As such, merely providing any form of authorization to someone who requests a release of information, such as a *requestor*, would broadly read on the claimed limitations. In this regard, Examiner notes that Edelson teaches "[a]ny electronic release made externally using the data access control features described herein can be assured of always being authorized by whatever entity, be they patient, physician or organization, that has proprietary rights in the data" and "[p]atient records should use a standard identifier to be clearly and distinctly identified with a confidence level appropriate to the expected patient population in the lifetime of the system so that the records of patients with similar or identical names are not confused. If desired, a coded alphanumeric patient identifier (not shown) may be used. Alternatively, or in addition, other unique patient identifiers such as social security numbers may be used alone or as secondary references in

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conjunction with patient names and the like.... More relevant to security is proper identification of a user to whom patient data is released or from whom new data is received by the host computer facility” (Edelson; column 16, lines 19-24, column 17, lines 26-39). As well Edelson teaches “[u]sing the system as described herein, all transactions generate an audit trail and are authorized or preauthorized by the patient” (Edelson; column 31, lines 61-63). Examiner interprets these teachings as reading on Appellant’s argued limitations.

In response to Appellant's assertion starting in paragraph 1 on page 9 of the Appellant's Brief that "Edelson also does not disclose ‘sending, by the requestor, the cover letter along with a patient authorization letter to a processing center, for completing the order,'" Examiner respectfully disagrees. Examiner notes that on page 11 of Appellant’s specification in paragraph 2 Appellant defines “cover letter” to be as follows:

“After making all the necessary selections, the insurance company is provided with ‘an authorization for release of records and documents’ cover letter (“cover letter” hereinafter) in step 414. The cover letter can be downloaded ...[...]...in PDF format or any other format...[...]...establishes a unique identifier for each order.”

Thus, when given its broadest reasonable interpretation, a "cover letter" is nothing more than an authorization provided for completing an order or for releasing information. As such, merely providing any form of authorization to someone who requests a release of information, such as a *requestor*, would broadly read on the claimed limitations. In this regard, Examiner notes that Edelson teaches “[s]ecurity may be provided by password protection operating hierarchically on one or more levels, to provide varying degrees of access according to the user's level of authorization, as desired. Additional password or numeric code control may protect

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sensitive system-accessed information, for example, patient records, or parts thereof, or physician-user data, including personal lists and prescribing profiles. Patient record access codes can, in selected instances, be patient provided, or granted by intelligent security control cards, having been furnished [reads on "sent"] to the patient [reads on "requestor"] by a system administrator, or agent, prior to the physician encounter. Physician or other user access to a patient's record, or to sensitive details thereof, can thereby be restricted to a need-to-know basis. Access by third parties to physician-related data can be similarly protected" (Edelson; column 9, line 66 to column 10, line 14). As well Edelson teaches "[u]sing the system as described herein, all transactions generate an audit trail and are authorized or preauthorized by the patient" (Edelson; column 31, lines 61-63). Examiner interprets these teachings as reading on Appellant's argued limitations.

In response to Appellant's assertion starting in the last paragraph on page 9 of the Appellant's Brief that " Eberhardt and Edelson do not disclose sending two letters..." Examiner respectfully disagrees. Examiner notes that Edelson's system allows multiple authorized users to access patient records. For example, insurance companies requesting access and patients authorizing access both send authorizations or cover letters to allow the central system to release patient records. Edelson's invention provides for multiple levels of security, ensuring an audit trail and/or log of activities, and allowing for multiple types of identifiers (Edelson; column 17, lines 5-62). In this regard, Edelson states "[r]elease of such data to third parties can be controlled to safeguard the privacy of the prescriber, or other health care provider, by ...[...]. data access protocols specifying who, or what organization, department or group, may access what data,

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when they may access it and what they can do with it " (Edelson; column 13, lines 41-46).

Examiner interprets these teachings as reading on Appellant's argued limitations.

In response to Appellant's argument starting in paragraph 2 of page 10 of the Appellant's Brief that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

And modern case law has clearly and explicitly held that in order for the references to be combined the references need not explicitly teach or suggest every element of the combination as well as how to use such a combination. For example, the Court in *In re Fritch* stated "[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. [emphasis added]" *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lahu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Each applied reference does not expressly suggest combination with the other respective references; however, the Examiner has shown that motivation for combining the references existed in the prior art. The "modification" referred to in *In re Fritch* involves extensive changes to the primary references. Such is not the case in the present combinations, where all modifications proposed by the Examiner are taught by the

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references and that knowledge generally available to one of ordinary skill in the art. Therefore, the combination of references is proper and the rejection maintained.

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

In the instant case, however, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. Note, for example the motivation for combining Eberhardt and Edelson, on page 6, paragraph 2 of the final office action (paper number 9), which states "...with the motivation of making integrated patient-specific information readily available to medical prescribing professionals, to utilize medical information which is widely distributed geographically, and to enable such access in the light of proprietary, liability and patient confidentiality concerns (Edelson; column 2, lines 8-15)." As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

In response to Appellant's argument starting in paragraph 3 of page 11 of the Appellant's Brief that "[t]he Final Office Action does not assert that Coli discloses 'providing to the requestor a cover letter having an identifier, the identifier having order information' and 'sending, by the requestor, the cover letter along with a patient authorization letter to a processing center for completing the order,'" Examiner respectfully notes that the Coli reference was not used to address this limitation. Rather it was the Edelson reference, and not the Coli reference, that was used to address this recited limitation. The Coli reference was applied to teach a system and method wherein the online location comprises a web site (Coli; see at least column 8, lines 56-60, column 10, lines 15-18).


Conclusion

Appellant's arguments at pages 6-12 of the Appeal Brief do not appear to persuasively require a withdrawal of the Examiner's grounds of rejection. As specified in the remarks and rebuttals given above, Appellant's arguments apparently fail to appreciate the clear and unmistakable suggestions provided in the prior art of record, and relied upon by the Examiner for motivation to combine well-known elements of the prior art. As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner both in the present Examiner's Answer as well as the previous Office Action (paper number 9), *Ex parte Levensgood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

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Thus, in light of the reasons and responses given above, it is respectfully submitted that a *prima facie* case of obviousness has been clearly established by the Examiner.

For the above reasons, it is believed that the rejections should be sustained.


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Respectfully submitted,



Natalie Pass
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November 27, 2004

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